

REMARKS

The outstanding Office Action addresses claims 1, 3-15, and 37. Applicants appreciate the Examiner's indication that claims 7-15 represent allowable subject matter and that these claims would be allowed if rewritten in independent form. Applicants submit, however, that independent claims 1 and 37 represent allowable subject matter, and reconsideration and allowance thereof is respectfully requested.

Rejections Pursuant to 35 U.S.C. §103(a)

The Examiner rejects claims 1, 3-6 and 37 pursuant to 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 5,201,739 of Semm in view of U.S. Patent No. 5,944,729 of Blake. The Examiner relies on Semm to disclose the claimed invention, but admits that Semm fails to teach a flexible member attached to the body, as required by independent claims 1 and 37 of the present invention. Thus, the Examiner relies on Blake to disclose the use of a flexible member.

As shown in Figure 1, Semm discloses forceps having first and second gripping handles that, when brought together, are effective to open first and second gripping members that are biased with respect to one another. Blake, on the other hand, discloses a radiopaque vascular clamp having a radiopaque string attached thereto. The string is merely adapted to increase x-ray visibility of the clamp. These devices are clearly very distinct devices that are used for entirely different purposes. A person having ordinary skill in the art would not rely on a reference directed to a vascular clamp to modify the teachings of a reference directed to forceps. These differences alone are sufficient to preclude one skilled in the art from combining Blake's flexible string with Semm's device in order to create a device as taught by the present invention.

Applicants further note that Semm's forceps are not implanted in a patient, and thus the use of a radiopaque string, as taught by Blake, would serve no purpose on Semm's device. In fact, because Semm already provides a handle for manipulating tissue being grasped, one of ordinary skill in the art would not be motivated to provide a flexible member, as taught by Blake.

The Examiner has failed to identify the necessary motivation to combine the references, and therefore has not established a prima facie case of obviousness. There is no suggestion or motivation to modify Semm to include any type of flexible member, much less the radiopaque string taught by Blake, and the use of such a string would be meaningless. Accordingly, the Examiner has failed to provide motivation to combine the references, and therefore independent claims 1 and 37 are not obvious over Semm in view of Blake and therefore represent allowable subject matter. Claims 3-15 are allowable at least because they depend from an allowable base claim.

Conclusion

In view of the amendments and remarks above, Applicants submit that claims 1, 3-15, and 37 are in condition for allowance. Applicants encourage the Examiner to telephone the undersigned in the event that such communication might expedite prosecution of this matter.

Respectfully submitted,

Date: November 18, 2003


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